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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/741,200

12/19/2000

Heung-For Cheng

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7689

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7590

10/31/2003

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EXAMINER

NGUYEN, MERILYN P

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 10/31/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,200

Applicant(s)

CHENG, HEUNG-FOR

Examiner

Merilyn P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 10 March 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

DETAILED ACTION

This is in response to request for reconsideration filed 07/31/03.

Specification

1. The disclosure is objected to because of the following informalities:

- o At page 3, " summary of the invention" is missing.

Appropriate correction is required.

Applicant, in his response filed 07/31/03 (paper #9) argues that a summary of the invention is not statutorily required. In response, the examiner contends that a summary of the invention in the instant case is important to the understanding of the overall invention and is, thus, required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S. 6427164) in view of Goodhand et al. (U.S. 5923848) (Goodhand). Regarding claims 1 and 11,

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Reilly disclose: A method and an apparatus for reducing network bandwidth wastage incident to sending an electronic document to a nonexistent member of a distribution list, comprising:

a machine accessible medium having instructions encoded thereon, which when executed by the machine (col. 3, lines 61 to col. 4, lines 9, Reilly), are capable of directing the machine to perform receiving a document by a document distribution server (col. 6, lines 66 to col. 7, lines 26, Reilly);

recording in a database an identifier for the document and the distribution list (col. 7, lines 28-62, Reilly);

distributing the document to said members of the distribution list (col. 7, lines 28-62, Reilly);

receiving, in response to distributing to a first member of the distribution list, an error message comprising the identifier (col. 8, lines 8-14, Reilly);

looking up the identifier in the database so as to identify the distribution list (col. 8, lines 15-30, Reilly).

However, Reilly didn't disclose: deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages. On the other hand, Goodhand disclose deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages (col. 13, lines 40-54, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the instructions for the step for deleting member from the distribution list in the system of Reilly as taught by Goodhand. The

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motivation being to enable the user to automatic deleted unknown user name in the distribution list to avoids receiving error messages during the transmission.

The Examiner directs applicant's attention to column 3, lines 3-10 of Reilly. At the noted excerpt, Reilly specifies that if a forwarding address does not exist, the reference will not attempt to resolve the discrepancy. Instead, Reilly allows the user to correct or update the address. Because Reilly desires an updated distribution list, it itself would suggest auto deletion step.

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Reilly/Goodhand disclose: wherein said wastage comprises bandwidth required for: said distributing the document to the nonexistent member (col. 7, lines 28-62, Reilly);

said error message received in response to said distributing (col. 7, lines 28-62, Reilly);
a reply by a second member of the distribution list, in response to said distributing, which is distributed to the nonexistent member; and an error message responsive to said reply (col. 8, lines 50 to col. 9, lines 10, Reilly).

Regarding claims 3 and 12, all the limitations of these claims have been noted in the rejection of claims 1 and 11, respectively. In addition, Reilly/Goodhand disclose: wherein members of the distribution list receive distributions addressed such that replies to said distributions are directed to said members of the distribution list (col. 8, lines 31-49, Reilly).

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Regarding claims 4 and 13, all the limitations of these claims have been noted in the rejection of claims 3 and 12, respectively. In addition, Reilly/Goodhand: disposing a Messaging Application Programming Interface (IVIAPI) application program within a first computing device (col. 13, lines 52-67, Goodhand); composing by the user of the document with said application program (col. 15, lines 64 to 16, col. 6, Goodhand); and disposing the document distribution server in a second computing device (col. 15, lines 50-57, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the MAPI application program use for composing and disposing in the system of Reilly as taught by Goodhand. The motivation being to make it easy for users to write message application that are independent of the underlying message system and implement message features with a small amount of code.

Regarding claims 5 and 14, all the limitations of these claims have been noted in the rejection of claims 4 and 11, respectively. In addition, Reilly/Goodhand discloses: wherein said application program includes an object-oriented programming language (col. 15, lines 35-49, Goodhand).

Regarding claims 6 and 15, all the limitations of these claims have been noted in the rejection of claims 4 and 11, respectively. In addition, Reilly/Goodhand discloses: wherein said application program comprises Microsoft outlook e-mail functionality (col. 8, lines 37-49, Goodhand).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Reilly/Goodhand discloses: providing a Microsoft windows operating system environment having a message application programming interface (MAPI) (col. 15, lines 27-34, Goodhand); disposing a Messaging Application Programming Interface (MAPI) application program within a first computing device (col. 13, lines 52-67, Goodhand); composing by the user of the document with said application program (col. 15, lines 64 to col. 16, line 6, Goodhand); and disposing the document distribution server in a second computing device (col. 15, lines 15-67, Goodhand).

Regarding claims 8 and 17, most of the limitations of these claims have been noted in the rejection of claim 1 above. It is therefore rejected as set forth above. In addition, Reilly/Goodhand disclose: sending the electronic document with said MAPI application program col. 14, lines 9-25, Goodhand); executing an e-mail application program utilizing a selected one of: Microsoft Messaging Application Programming Interface (MAPI)-based, and Microsoft Active Messaging (col. 13, lines 1-10, Goodhand); addressing the electronic document to the distribution list (col. 13, lines 29-39, Goodhand).

Regarding claims 9 and 18, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, Reilly/Goodhand disclose: further comprising: receiving the error message (col. 7, lines 28-62, Reilly); receiving the electronic document by a distribution server which performs said distributing the electronic document (col. 6, lines 66 to col. 7, lines 26), and looking up the identifier (col. 8, lines 15-30, Reilly).

Regarding claims 10 and 19, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, Reilly/Goodhand disclose: further comprising: determining the identifier based on attributes of the electronic document, said attributes comprising a subject identifier, a sending time, and a distribution list identifier (col. 15, lines 50-57, Goodhand).

Regarding claim 16, all the limitations of this claim have been noted in the rejection of claim 11. In addition, Reilly/Goodhand disclose further comprising: a second computing device, communicatively coupled to the system, in which the document distribution server is disposed (col. 15, lines 15-25, Goodhand); and wherein said instructions include further instructions capable of directing the machine to perform: executing a Microsoft Windows operating system environment providing a Messaging Application Programming Interface (col. 15, lines 27-34, Goodhand).

Response to Arguments

3. Applicant's arguments filed on 07/31/03 about the claim rejection of the last Office Action (Paper #8) have been fully considered, but they are not persuasive.

Applicant argues that Reilly does not address a problem of identifying when a distribution list has an erroneous addressee, and removal of the erroneous addressee to avoid error messages when messages are subsequently addressed to the distribution list. The examiner respectively disagree, as earlier addressed above in claim 1, col. 3, lines 3-10 of Reilly clearly

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teaches the applicant limitation of identifying when a distribution list has an erroneous addressee, and col. 7, lines 27-41 of Reilly teaches the removal of the erroneous addressee to avoid error messages. Furthermore, the examiner respectively point out that the Reilly et al. alone teaches the claim limitations. The Goodhand et al. is used by examiner in the rejection to clarify the obviousness of automatically deleting unknown username/addressee in the distributed list of Reilly to avoid receiving further error messages. Thus, the combination of Castelli and Sheppard clearly teach or suggest the limitations of the applicant's invention. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN

MN

October 17, 2003


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100